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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,256

08/23/2006

Sven Johannes Jeurissen

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

PATEL, ASHOK

ART UNIT

PAPER NUMBER

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,256	<b>Applicant(s)</b> JEURISSEN ET AL.	
	<b>Examiner</b> Ashok Patel	<b>Art Unit</b> 2889	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. Applicant's arguments filed January 09, 2009 have been fully considered but they are not persuasive.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans et al (USPN 3602759), of record.

As to claims 1-3 and 5, Evans et al disclose applicant's claimed fluorescent lamp (at least Figures 1 and 7; embodiments I and V) including:

a glass discharge vessel (envelope 12) in which a gas is present (col. 2, embodiment 1), which discharge vessel is on two sides provided with a tubular end portion having a longitudinal axis, which end portion includes a glass stem (14 or 15), wherein

an exhaust tube (although not shown, it is essential for evacuating the envelope, inserting discharge fill, sealing the envelope etc.) extends axially outwardly from the stem (5), and

an electrode (16 or 17) extends axially inwardly through the stem for generating and maintaining a discharge in the discharge

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vessel (12), the electrode includes two pole wires (lead wires) held in position by the stem and connected to plug pins (20) of an end cap (32) fixed to the end portion, and

the end cap (32) is at least substantially made of a heat shrink material (PVC, polyolefin; see col. 2, last paragraph).

As to method claims 5-6, since Evans et al's disclosed fluorescent lamp includes all product features as recited in applicant's product claims 1-3, Evans et al's disclosed device is considered as formed by the method as recited in applicant's method claim number 5. The artisan seeking the apparatus claim would necessarily perform the method as claimed.

As to claims 7 and 8, these claims are rejected since language is similar to that of claims 2 and 3.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 4 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al, as applied to claim 1.

As to claims 4 and 9-12, Evans et al do not disclose the heat shrink material activated at a temperature varying between 80° and 200° C, preferably between 100°C and 150°C. However, since heat shrink material is known for shrinkage when receiving suitably appropriate heat. In light of this, applicant's claimed heat shrinking temperature range would have been obvious to one of ordinary skill in the art for shrinking the plastic material of the fluorescent lamp.

Further, it has been further held that where general conditions of the claim are discovered in the prior art, discovering the optimum or workable heat shrinking temperature range involves only routine skill in the art. In re Aller, 105 USPQ 233.

As to claims 4, 11 and 12, alternatively, the claim recites heat shrinking material being activated at a specific temperature range. This activating process renders claims 4, 11 and 12 of product-by-process nature. The courts have been holding that: "-- In spite of the fact that a product-by-process claim may recite

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only process limitations, it is the product which is covered by the claim and not the recited process steps--. (In re Hughes, 182 USPQ 106)--". Also --Patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious. (In re Pilkington, 162 USPQ 147)--."

Accordingly, "--a rejection based on 35 U.S.C. section 102 or alternatively on 35 U.S.C. section 103 of the statute is eminently fair and acceptable." (In re Brown and Saffer, 173 USPQ 685 and 688). --The determination of the patentability of product-by-process claim is based on the product itself rather than on the process by which the product is made--. In re Thrope, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

As such, no patentable weight is given to process step recited in claims 4, 11 and 12.

6. The Examiner replies to applicant's arguments as follows.

Applicant argues that Evans does not disclose the end cap made of a shrinkable material. This is not found persuasive since the end cap does include the heat shrinkable material (22). The heat shrinkable material (22) is a part of the end

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caps of the envelope since it encircles the adjacent body portions of the base members (18); col. 2, lines 55-68.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok Patel whose telephone number is 571-272-2456. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minh-Toan Ton can be reached on 571-272-2303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ashok Patel/  
**Ashok Patel**  
**Primary Examiner**  
**Art Unit 2889**